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EXAMINER

THALER, MICHAEL H

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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte GEOFFREY H. WHITE and WEIYUN YU

Appeal 2007-0850
Application 10/733,292
Technology Center 3700

Decided: January 23, 2008

Before DEMETRA J. MILLS, ERIC GRIMES, and LORA M. GREEN,
Administrative Patent Judges.

GRIMES, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

Appellants have requested rehearing of the decision entered May 18, 2007 (hereafter “Decision”). The Decision entered new grounds of rejection of claims 12-36 under 35 U.S.C. §§ 102(e) and 103. We decline to withdraw the new grounds of rejection. The request for rehearing is denied.

DISCUSSION

Appellants address their arguments on rehearing to claim 12 (Req. Reh'g 4). Therefore, claims 13-36 stand or fall on rehearing with claim 12. 37 C.F.R. § 41.37(c)(1)(vii).

Appellants argue that Piplani's statement that the apices in its device extend "a substantial distance beyond the open end" of the device is an inadequate basis on which to conclude that the apices extend far enough to extend across a lumen of a second vessel, as required by claim 12 (Req. Reh'g 6). Appellants argue that "'substantial' is a relative term. Piplani provides no metric to specify what 'substantial' means." (*Id.*) "[A]ll 'substantial' means is not insubstantial. It does not for example mean at least 1, 3, 5, or 15 millimeters." (*Id.* at 7.)

This argument is not persuasive. Appellants provide no evidentiary basis for their assertion that those skilled in the art would not have understood Piplani's "substantial distance" to mean at least 1, 3, 5, or 15 millimeters, distances which in any case are not recited in claim 12. Nor have Appellants provided any evidence to rebut our reasoning that "[i]n view of the drawings, the explicitly stated dimensions, and the disclosure that one set of wire apices extends 'a substantial distance' from the body of the graft, it is reasonable to conclude that the wire apices of Piplani's device would extend a sufficient distance from the body of the graft such that the apices would be capable of extending across the lumen of an intersecting vessel" (Decision 10-11).

Appellants argue that our reliance on *In re Best*, 562 F.2d 1252, 1254-55 (CCPA 1977), is improper because "Best relates to products formed by a

process wherein the novel property ascribed to the claimed product results from alleged differences in the process of its manufacture,” while “[n]o allegedly novel feature of a composition of matter based upon a process of making a composition is involved in this case” (Req. Reh’g 6). Appellants also argue that they made the showing required by *Best* “in their appeal brief, pointing out that Piplani did not expressly or inherently disclose” (*id.*).

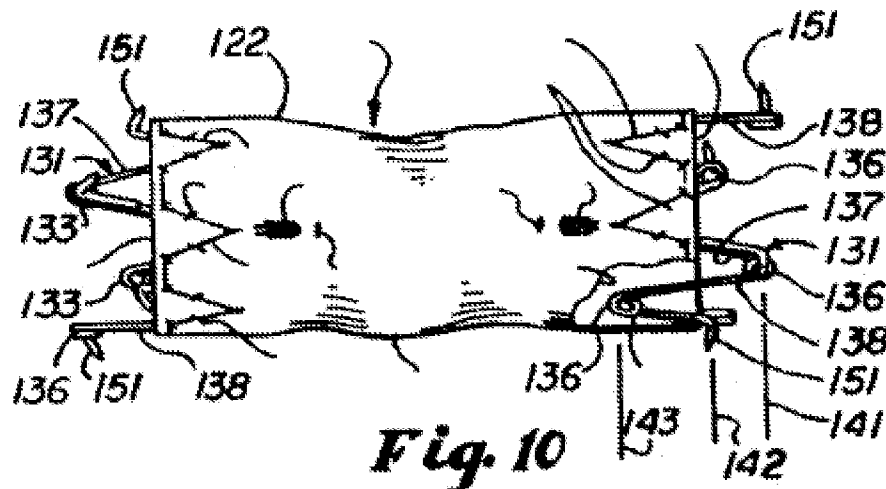
We disagree with Appellants’ interpretation of the case law. The shifting of evidentiary burdens described in *Best* applies in contexts other than that of comparing chemical compositions. *See, e.g., In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990) (“[W]hen the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.”). The rebuttal is not limited to comparative testing of claimed and prior art products, but can take a variety of forms. *See id.* (“In response to the PTO’s asserted *prima facie* case the applicant may argue that the inference of lack of novelty was not properly drawn, for example if the PTO did not correctly apply or understand the subject matter of the reference, or if the PTO drew unwarranted conclusions therefrom.”).

We have reviewed the arguments made in the Appeal Brief (pages 7-11) but do not agree with Appellants that they have established that Piplani’s device does not meet the limitations of claim 12, for the reasons discussed in the Decision (pages 11-12).

Appellants also argue that Piplani refers to Lazarus (U.S. Patent 5,275,622) for additional details about the disclosed device (Req. Reh’g 7-8). According to Appellants, Lazarus teaches that “the longitudinal

distances between the apices should be minimized” (*id.* at 10 (emphasis removed)), that “the planes 141, 142, 143 should be staggered in the longitudinal direction by an amount slightly greater than the extent of each hook in the longitudinal direction” (*id.* at 11), and that “spacing between apices (at which the hooks are connected) should be no more than 1-2 millimeters” (*id.* at 11-12). Thus, Appellants conclude that “the new grounds of rejections are improper because they are not based upon apices having a longitudinal spacing of no more than 2 millimeters” (*id.* at 12).

We disagree with Appellants’ interpretation of Lazarus. Appellants rely on Lazarus’ description of its Figure 10, which is reproduced below (with unnecessary reference numerals omitted):



Lazarus states that Figure 10 shows “that spring means 131 have apices lying in three longitudinally spaced-apart parallel planes 141, 142 and 143 which are spaced with respect to the longitudinal axis of the tubular member 122” (Lazarus, col. 8, ll. 60-63). As Appellants point out, Lazarus discloses that

the spring force created by the helical coils 136 at the apices 133 is largely determined by the diameter of the wire. The greater the diameter of the wire, the greater the spring force applied to the struts or legs 137 and 138 of the vees. Also, *the longer the distances are between the apices lying in planes 141 and 142, the smaller the spring force that is applied to the legs or struts 137 and 138.* It therefore has been desirable to provide a spacing between the outer extremities of the legs or struts of approximately one centimeter, although smaller or larger distances may be utilized.

(Lazarus, col. 9, ll. 35-46, emphasis added.)

Appellants argue that “the italicized text indicates positively that *the longitudinal distances between the apices should be minimized.* What this means is that Lazarus teaches, and hence Piplani teaches, that the apices are in actual design close to one another relative to the other dimensions of the graft. Hence, this passage in Lazarus contradicts the panel’s conclusion upon which the new grounds are based.” (Req. Reh’g 10.)

We disagree. Lazarus states that the apices in plane 141 are “spaced from the end on which they are mounted” (Lazarus, col. 9, ll. 8-9). The passage quoted above simply states that the farther plane 141 is from the outer end of the tubular member (and plane 142), the lower the spring force applied to the struts or legs 137/138, and therefore, plane 141 should not be *too* far from the end of the tubular member. How far is too far, Lazarus does not say.

However, Lazarus does state that it “has been desirable to provide a spacing between the outer extremities of the legs or struts of approximately one centimeter” (*id.* at col. 9, ll. 42-46). This statement is most reasonably read to refer to the distance between planes 141 and 142, which are the “outer extremities” of the legs or struts that end in apices 133. Thus,

Lazarus expressly recommends that planes 141 and 142 be separated by a distance of one centimeter, “although smaller or larger distances may be utilized” (Lazarus, col. 9, ll. 45-46).

We do not agree with Appellants’ interpretation of Lazarus as “teach[ing] that the planes 141, 142, 143 should be staggered in the longitudinal direction by an amount slightly greater than the extent of each hook in the longitudinal direction” (Req. Reh’g 11). Appellants have pointed to no disclosure in Lazarus that supports the asserted teaching. Nor do we agree with Appellants that Lazarus teaches that “spacing between apices (at which the hooks are connected) should be no more than 1-2 millimeters” (*id.* at 11-12). The passages cited by Appellants as support for this teaching refer only to the size and orientation of the hook-like elements 151, not the spacing between the apices 133. As discussed above, we read Lazarus to recommend a spacing of one centimeter between the planes 141 and 142 in which the apices lie.

Finally, Appellants argue that “[g]iven that this case is under appeal and appellant[s] cannot submit new evidence, the new grounds of rejection is [sic] untenable” (Req. Reh’g 12).

This argument is also unpersuasive. An appellant has two options for responding to a new ground of rejection in a Board decision: file a request for rehearing or reopen prosecution by “[s]ubmit[ting] an appropriate amendment . . . or new evidence relating to the claims so rejected.” 37 C.F.R. § 41.50(b).

Appellants chose to rely on the evidence of record rather than submitting new evidence to the Examiner. For the reasons discussed above

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and in the Decision, the evidence of record does not support Appellants' position.

REHEARING DENIED

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